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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,736	09/30/2003	Christophe Guy Lecomte	OSSUR.046A	3977

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EXAMINER

STEWART, ALVIN J

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,736

Applicant(s)

LECOMTE ET AL.

Examiner

Alvin J Stewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-39 is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8, 10, 14, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips et al US Patent 6,511,512 B2.

Phillips discloses a shock module prosthesis having an inner support member (28), an outer support member (26) being coaxially and capable of relative rotation and axial translation, a resilient element (30), a torque resisting cuff (34) having a generally tubular shape and is proximally attached to one support member and distally attached to another support member, an adapter (36).

Regarding claims 2 & 3, bolt (41) (see Fig. 2) can be called a hinged pinch bolt.

Regarding claim 10, see Figure 7.

Regarding claim 14, see col. 21, lines 31-43.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al US Patent 6,511,512 B2.

Phillips et al discloses the invention substantially as claimed. However, Phillips et al does not disclose an axial length of the cuff that is greater about half the axial length of the inner member and an o-ring placed under the distal end of the inner member.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to disclose an axial length of the cuff that is greater about half the axial length of the inner member and an o-ring placed under the distal end of the inner member because Applicant has not disclosed that the axial length and the o-ring provide an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the axial length of the inner member and the sealed connection at the distal end of the inner member because the axial length and the lack of an o-ring in the Phillips et al reference will not produce drastic change in the intended use of the invention.

Therefore, it would have been an obvious matter of design choice to modify Phillips et al reference to obtain the invention as specified in claims 9, 17.

Claims 11-13, 15, 16, and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al US Patent 6,511,512 B2.

Phillips et al discloses the invention substantially as claimed. However, Phillips et al does not disclose a list of height distances.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the different ranges of claims 11-13, 15, 16 and 19-23, since it has

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been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Additionally, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the vertical height from the ground to the top of the adapter because Applicant has not disclosed that the distance about 160 mm or less provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the distance as shown in the Phillips et al reference because it will perform the same function that is absorbing torsional and/or axial forces.

Therefore, it would have been an obvious matter of design choice to modify the Phillips reference to obtain the invention as specified in claims 19-23.

Regarding claim 24, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the vertical height from the ground to the top of the adapter because Applicant has not disclosed a distance between the resisting cuff and the upper end of the support member provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the distance as shown in the Phillips et al reference because it will perform the same function that is absorbing torsional and/or axial forces.

Allowable Subject Matter

Claims 28-39 are allowed.

Response to Arguments

Applicant's arguments filed December 07, 2004 have been fully considered but they are not persuasive.

Regarding claims 1-7, the Applicant's representative enter new limitations disclosing that the adapter is secured to one of the inner and outer support members but remains unsecured relative to the resilient element. The Examiner wants to point out that the adapter it might be touching the resilient element but both structures are not secured to each other. They can easily be separated and the patient can replace the resilient element by another resilient element.

Regarding the word "configured to", this phrase has been identified as an intended use limitation because is typical of claim limitations which may not distinguish over prior art according to the principle. It has been held that the recitation that an element is "configured to" performing a function is not a positive limitation but only requires the ability to so perform.

Regarding claim 8, the Applicant's representative discloses that the prior art does not disclose a resilient element in a pre-compressed state. The Examiner wants to clarify that the Applicant's representative has not positively claim that the resilient element is in a pre-compressed state. Line 6 of claim 8, only discloses a name identifying a structure not positively claiming that the resilient element is in a pre-compressed state. However, it is an inherent characteristic for this type of shock absorbers to have a spring in a pre-compressed state in order to obtain a tensile strength in the prosthetic device and avoid unwanted down-side movements.

Regarding claim 18, the Applicant's representative is positively claiming the resilient element in a pre-compression state. However, it is an inherent characteristic for this type of

shock absorbers to have a spring in a pre-compressed state in order to obtain a tensile strength in the prosthetic device and avoid unwanted down-side movements.

Regarding claims 19-23, the Examiner maintains the rejection and add a design choice rejection because the Applicant's representative has fails (in the remarks and in the specification) to show the importance of having a height range. The Applicant's representative has only mentioned that the optimum height for the prosthesis depends on the needs of the particular patient and it seems that the optimum height is not the inventive part of the invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J Stewart whose telephone number is 703-305-0277. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alvin J Stewart
Primary Examiner
Art Unit 3738

February 09, 2005.